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IN THE

Supreme Court of the United States

OCTOBER TERM, 1951.

No. 254

AMERICAN STEEL FOUNDRIES,

Petitioner,

vs.

HOLLAND COMPANY,

Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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STATEMENT OF THE CASE.

Respondent sued Petitioner for infringement of Claim 10 of the Goodwin Patent (R. 190-199) by making and selling railroad car trucks (R. 3) identified as "Ride-Control Trucks Type A-3" shown and described in several publications. (R. 117-134.)

The District Court found non-infringement, and did not pass on validity. (R. 181.)

The Court of Appeals reversed the judgment of non-infringement and remanded the cause with directions to make appropriate findings upon the issue of validity. (R. 272.)

The accused trucks fall clearly within the words of the claim in suit, but Petitioner contends that the proceedings in the Patent Office require the claim to be so limited that the Type A-3 trucks avoid infringement.

The District Court accepted Petitioner's argument and sustained the defense. The Court of Appeals rejected that defense and found infringement.

THE QUESTION PRESENTED.

Whether this Court will issue a writ to review the Court of Appeals' finding of infringement over the untenable defense.

ARGUMENT.

This is a patent infringement case in which Respondent, assignee of the Goodwin patent, brought suit for infringement of Claim 10. (R. 199.)

The District Court found no infringement, but did not pass upon validity. (R. 181.)

The Court of Appeals reversed the judgment of non-infringement, and remanded the cause with directions to make appropriate findings upon the issue of validity under several authorities cited. (R. 272.)

It would seem that certiorari is unsuited in this posture of the case.

The Petition does not assert that there is a conflict of decisions with respect to the Goodwin patent. The only other litigation involving that patent was settled by the infringer's taking a license. (R. 37 and 39.)

The Petition does not assert that the case involves any important or novel question of law. On the contrary, it asserts that the law is settled by decisions of this Court.

The sole ground on which the Petition asks a writ of certiorari is that the Court of Appeals reversed the judgment of non-infringement, because the District Court "was clearly in error in holding that Defendant did not infringe." (R. 271.)

THE DISTRICT COURT ACCEPTED PETITIONER'S ARGUMENT IN SPITE OF PLAIN WORDS OF THE PATENT TO THE CONTRARY.

In finding no infringement, the District Court accepted Petitioner's fallacious argument that, in spite of the plain words of the patent claims, Goodwin had eliminated from his patent devices for applying pressure on the friction shoes independent of the load, which were referred to as "Class Two devices." (R. 179 and 180.)

The language of the patent shows that to be clearly wrong.

Claim 2 requires:

"* * * spring pressed plates interposed between the shoes and the frame to add a constant pressure irrespective of the load." (R. 198.)

It cannot be that the express requirement of Claim 2 was eliminated from the patent, for it is still there.

This intrinsic evidence on the face of the patent is alone sufficient to show that the District Court "was clearly in error," as the Court of Appeals found.

But suppose this evidence in the patent itself was absent. Whether or not "Class Two devices were eliminated from the Goodwin patent by the applicant * * *" (R. 180), as the District Court said, depends on the file wrapper, interpretation of which was as open to the Court of Appeals as it was to the District Court. No credibility of witnesses was involved.

The Court of Appeals found nothing in the file wrapper to impose limitations on Claim 10 that are not expressed by its language. But it did find that Claim 10 covered Goodwin's central, vital concept, and that Petitioner adopted that concept in its entirety. (R. 271.) Those findings are what Petitioner wants this Court to review.

THE EXAMINER SUGGESTED CLAIM 10 TO GOODWIN.

Claim 10 in suit was one of three claims that were found allowable in the rival application of Shafer, and were suggested to Goodwin (R. 167, 168) for the purpose of interference in conformity with the practice prescribed by Rule 96 of the then existing Rules of Practice of the Patent Office, which read:

> "Whenever the claims of two or more applications differ in phraseology, but relate to substantially the same patentable subject matter, the examiner shall suggest to the parties such claims as are necessary to cover the common invention in substantially the same language."

The suggestion of the Examiner was an affirmative ruling by that official that Goodwin had a right to make Claim 10, and that it should take its place in his application subject to the award of priority which followed in due course.

Claim 10 was merely one of several claims suggested to cover common invention in substantially the same language. It was not necessary that each claim cover all the common invention. It was not necessary that the claim be taken from either of the applications, as will be clear from the language of the rule. The suggested claim or claims might just as well have been framed by the Patent Office, as was done in *Hildreth* v. *Mastoras*, 257 U. S. 27 at 29 and 32, 66 L. Ed. 112 at 115 and 116. Claim 10 thus came to Goodwin clear and unstained by any rejection or cancellation or amendment that would let Petitioner escape infringement.

THE DEFENSE OF NON-INFRINGEMENT IS NOT BASED ON LIMITATIONS IN CLAIM 10, BUT RATHER ON LIMITATIONS NOT EXPRESSED IN THAT CLAIM.

It is significant that nowhere does the Petitioner allege that:

There is an express limitation in Claim 10 not found in Petitioner's structure; or

In order to get the patent in suit, Goodwin gave up or acquiesced in the rejection of a claim corresponding to Claim 10, which might have raised an estoppel; or

That Claim 10 corresponds to cancelled Claims 4, 5, and 6 of the Goodwin application, or any of them.

If any one of those things was in the record, Petitioner would not have failed to point it out.

If there was a cancelled claim remotely corresponding to Claim 10 anywhere in the record, Petitioner would not have omitted a "deadly parallel of comparison."

Nothing was given up by Goodwin which Respondent now asserts by Claim 10.

CONCLUSION.

1. Certiorari would seem to be unsuited to a situation in which the Court of Appeals found infringement and remanded to the District Court to make appropriate findings on the issue of validity.

2. No conflict of decisions is asserted.

3. No novel or important question of law is presented.

4. The Petitioner seeks to have this Court review the finding made by the Court of Appeals that Claim 10 covers Goodwin's vital concept and Petitioner adopted that concept in its entirety.

The Petition for a Writ of Certiorari should be denied.

Respectfully,

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September 12, 1951.

Service of the above, together with a copy of same, acknowledged this ..... day of September, 1951.

.....

For the Petitioner.